

REMARKS

Claims 38-39, 44-48 and 54-69 remain pending after amendment. Claims 54-69 are new. Claims 1-36 were cancelled *without prejudice* pursuant to the Examiner's restriction requirement and Applicants' election of invention. Support for the amendment to the claims can be found throughout the originally filed specification, examples and claims and in particular, in the examples and in figures 2, 3 and 4. Note that the claimed subject matter has excluded compounds where R⁵ is H, R⁶ is CH₃, R⁷ is H and R⁸ is H (oroxylin A). No new matter has been added by way of the present amendment.

Applicant respectfully requests that the claim amendments presented herein be entered in the application as they place the application in a condition for allowance. Applicant maintains for the reasons explained below that presently pending claims 38-39, 44-48 and 54-69 as amended herein are allowable and should be passed to issue. Applicant addresses each of the Examiner's concerns in the sections which are presented hereinbelow.

The Rejection of Previously Pending Claims 37-39 and 44-48 Under 35 U.S.C. §112, Second Paragraph

The Examiner has rejection previously pending claims 37-39 and 44-48 under 35 U.S.C. §112, second paragraph for the reasons which are stated in the March office action on page 4. The Examiner has indicated that the previously presented claims omit a step of administering to a patient population. In response, Applicants have presented new independent claims 54 and 59 which contain the step of administering requested by the Examiner. It is respectfully submitted that the present invention as claimed fully complies with the requirements of 35 U.S.C. §112, second paragraph.

The Rejection of Previously Pending Claims 37-39, 44-46 and 48 Under 35 U.S.C. §102(e) as Being Anticipated by Lee

The Examiner has rejected previously pending claims 37-39, 44-46 and 48 under 35 U.S.C. §102(e) as being anticipated by Lee, et al., US. Patent no. 6,806,257 ("Lee") for the reasons which are stated in the office action on pages 4-6. Essentially, the Examiner is making an anticipation rejection based upon an inherency analysis, arguing that compositions which contain oroxalyin A in combination inherently anticipate the present invention. Notwithstanding the fact that Applicants strongly believe that Lee does not inherently anticipate the present invention regarding the use of oroxalyn A, in order to obviate the Examiner's rejection and place the application in condition for allowance, Applicants' have amended the previously pending claims and provided new claims 54-69. These claims are directed to methods which enhance the bioavailability of numerous bioactive agents by coadministering the compounds in effective amounts as claimed. After amendment, no method claim reads on or is directed to oroxalyn A (R^5 is H, R^6 is Me, R^7 is H and R^8 is H). Given that the basis for the anticipation rejection by Lee is directed to the use of oroxalyn A which is completely unrelated to the present invention (even though Applicants believe this rejection is without merit), it is respectfully submitted that the presently claimed invention is neither disclosed nor even obliquely suggested by the teachings of Lee. Applicants respectfully request that the Examiner withdraw his rejection of the prescnt invention over the disclosure of Lee.

The Rejection of Previously Pending Claims 37-39, 44-48 Under 35 U.S.C. §102(e) as Being Anticipated by Sheu

The Examiner has rejected previously pending claims 37-39 and 44- 48 under 35 U.S.C. §102(e) as being anticipated by Sheu, et al.,US. Patent no. 6,806,257 ("Sheu") for the reasons which are stated in the office action on pages 6-7. Here, the Examiner is again making an anticipation rejection based upon an inherency analysis, arguing that compositions which contain oroxalyin A in combination with ginseng inherently anticipate the present invention. Notwithstanding the fact that Applicants strongly disagree with Examiner and believe that Scheu does not inherently anticipate the present

invention regarding the use of oroxalyn A, in order to obviate the Examiner's rejection and place the application in condition for allowance, Applicants' have amended the previously pending claims and provided new claims 54-69. As noted above, these claims are directed to methods which enhance the bioavailability of numerous bioactive agents by coadministering the compounds in effective amounts as claimed. After amendment, no method claim reads on or is directed to oroxalyn A as discussed above. Given that the basis for the anticipation rejection by Sheu is directed to the use of oroxalyn A which is completely unrelated to the present invention (even though Applicants believe this rejection is without merit), it is respectfully submitted that the presently claimed invention is neither disclosed nor even obliquely suggested by the teachings of Sheu. Consequently, as in the case of the rejection based upon the disclosure of Lee, discussed above, Applicants firmly assert their view that the present invention is patentable over the disclosure of Sheu and respectfully request that the Examiner withdraw his rejection of the present invention as being anticipated.

It is respectfully submitted that the presently claimed invention is patentable over Shcu and Lee. For the above reasons, Applicants respectfully assert that the claims set forth in the amendment to the application of the present invention are now in compliance with 35 U.S.C. Applicants respectfully submit that the present application is now in condition for allowance and such action is earnestly solicited.

No fee is due for the presentation of the amendments to the claims made herein. A petition for an extension of time is enclosed as is authorization to debit Deposit Account 04-0838. Please charge any additional fee due or credit any overpayment to Deposit Account No. 04-0838.

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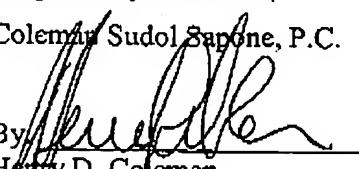
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CENTRAL FAX CENTER**AUG 19 2010**

If the Examiner believes that discussing the present application with the undersigned attorney may materially advance the prosecution of this application, She is cordially requested to telephone the undersigned at the telephone number listed below.

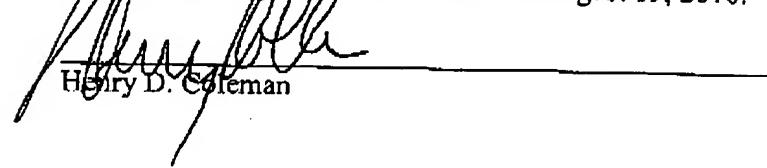
Respectfully submitted,

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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that this correspondence is being sent by facsimile transmission to Examiner Brian Yong S Kwon in Group Art Unit 1614 of the United States Patent and Trademark Office, at P.O. Box 1450 Alexandria, Virginia 22313-1450" on August 19, 2010.


Henry D. Coleman